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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,728	08/27/2001	Gwyn A. Cutsforth	2194-0042-23	2779

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
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EXAMINER

GITOMER, RALPH J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on August 7, 2003 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following omission(s) or provision is required. **Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.**

THE FOLLOWING CHECKED (X) ELEMENTS(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (incl. withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: Does not state whether claims were amended or are being currently amended

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Francine P. Mercer
Legal Instruments Examiner (LIE)

Applicant's election with traverse of Group II, claims 21-37, 57-61 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that no examples are shown for the reasoning. This is not found persuasive because each of the Groups are distinct and independent inventions as described.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

examiner to consider the applicability of 35 U.S.C. 103[®] and
potential 35 U.S.C. 102(f) or (g) prior art under 35
U.S.C. 103(a).

5 Claims are rejected under 35 U.S.C. 103(a) as being
unpatentable over .

10 It would have been obvious to one of ordinary skill in the
art at the time the invention was made to

15 Claims are rejected under 35 U.S.C. 112, first paragraph,
as containing subject matter which was not described in the
specification in such a way as to enable one skilled in the art
to which it pertains, or with which it is most nearly connected,
to make and/or use the invention.

20

25 Claims are rejected under 35 U.S.C. 112, first paragraph,
because the specification, while being enabling for , does not
reasonably provide enablement for . The specification does not

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In claim the terms " " lack enablement as it would require one of ordinary skill in this art undue experimentation to determine which would work in the instant invention.

The entire scope of the claims has not been enabled because:

1. Quantity of experimentation necessary would be undue because of the large proportion of inoperative compounds claimed.
2. Amount of direction or guidance presented is insufficient to predict which substances encompassed by the claims would work.
3. Presence of working examples are only for specific substances and extension to other compounds has not been specifically taught or suggested.
4. The nature of the invention is complex and unpredictable.
5. State of the prior art indicates that most related substances are not effective for the claimed functions.
6. Level of predictability of the art is very unpredictable.
7. Breadth of the claims encompasses an innumerable number of compounds.
8. The level of one of ordinary skill in this art is variable.

In re Wands, 858 F.2d 731, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)

Claims are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point
5 out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

In claim 24 preferred Markush terminology is ~~is~~ selected from the group consisting of. ~~is~~ Not all of the members of the group in
10 claim 24 are metal compounds.

The title of the invention is not aptly descriptive. A new title is required that is clearly indicative of the invention to
15 which the claims are directed.

The disclosure is objected to because of the following
20 informalities: . Appropriate correction is required.

The following prior art pertinent to applicant's disclosure is made of record and not relied upon:

Any inquiry concerning this communication or earlier
25 communications from the examiner should be directed to Ralph

Gitomer whose telephone number is (703) 308-0732. The examiner
can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm.
The examiner can also be reached on alternate Mondays. If
attempts to reach the examiner by telephone are unsuccessful, the
5 examiner's supervisor, Michael Wityshyn can be reached on (703)
308-4743. The fax phone number for this Art Unit is (703) 308-
4556. Any inquiry of a general nature or relating to the status
of this application should be directed to the Group receptionist
whose telephone number is (703) 308-1235. For 24 hour access to
10 patent application information 7 days per week, or for filing
applications electronically, please visit our website at
www.uspto.gov and click on the button Patent Electronic Business
Center for more information.

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Ralph Gitomer
Primary Examiner
Group 1651